

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Katsunobu HAYASHI

Confirmation No.: 7831

Appl. No.: 09/683,829

Tech. Center: 3694

Filed : February 20, 2002

Examiner: Mary Da Zhi Wang CHEUNG

For : COMPENSATION CONTRACT SUPPORTING SYSTEM, METHOD FOR  
SUPPORTING COMPENSATION CONTRACT, AND PROGRAM THEREOF

**STATEMENT BY ABRAHAM HERSHKOVITZ IN SUPPORT OF RENEWED  
PETITION UNDER 37 C.F.R. 1.181  
FOR WITHDRAWAL OF HOLDING OF ABANDONMENT**

Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Sir:

1. I am a Patent Agent with the firm of Hershkovitz & Associates, LLC ("the Firm"),  
a Firm I founded in 2003.

2. I am the final reviewer of work related to patent matters and serve as the 2<sup>nd</sup> pair of  
eyes reviewer of docket entries made by the docketing manager. The initial review of docket  
entries with the docket manager is with Dinh Nguyen, a patent attorney with the Firm.

3. The person performing docket entries on PROLAW during the March 2008  
relevant time frame was Jiaxiao Zhang, who is no longer with our Firm.

4. Some time in 2007 I agreed to have our Firm participate in a PTO Pilot, wherein

our Firm would receive PTO Office actions by e-mail, rather than regular mail. I received assurances from the PTO at that time that if we did not open and review an e-mail notification relative to an Office action, that we would receive a post-card reminder to view the relevant Office action.

5. Throughout 2008, our Firm received PTO Office Actions primarily by e-mail, which I then forwarded to the person in charge of docketing. During the March 18, 2008 time frame, that person would have been Ms. Zhang. Once she received an e-mail that included notice of an Office Action, she printed out the Office Action from the PTO private PAIR system, matched the Office Action with the relevant file and went over the docketing steps with Mr. Nguyen, relative to that Action.

6. Our Firm uses now, as it did throughout 2008, a dual docket system. The main docket system is based on a professional docketing software called PROLAW. The backup docket system is the widely available calendar system available with Yahoo e-mails. Ms. Zhang was the sole person handling entries into PROLAW. Additionally, she made manual entries on a daily Yahoo calendar printout for later updating on the computer.

7. Beginning on June 1, 2008, Carolina Rios was hired by our Firm and she began to perform docketing functions. Currently, Ms. Rios handles the PROLAW docketing system as well as the Firm's back-up Yahoo docket system, which were previously performed by her predecessor, Ms. Zhang.

8. Based on information and belief, on or about October 8, 2008, as part of the routine

docketing with Ms. Rios, Mr. Nguyen reviewed the print-out of the e-mail notification of an Office Action from the USPTO and the printed document along with the matched file for the above-identified patent application. As the Office Action was a Notice of Abandonment, Mr. Nguyen reviewed the file and concluded that the file did not have an Office Action after the Response our Firm filed on December 6, 2007.

9. I am aware of Ms. Rios' call to the USPTO to inquire about the situation for this application. Based on information and belief, Ms. Rios reported to Mr. Nguyen that the USPTO official stated that records indicated that for this Office Action, there was an e-mail notification on March 18, 2008.

10. When an e-mail notification of an Office Action is received by the Firm, the docketing manager would print a copy of the Office Action, and she would go over with Mr. Nguyen from a docketing of deadlines standpoint. Later on, usually within 1-3 days, Mr. Nguyen would review the printout of the copy of the Office Action and the report to the client that was generated by the Legal Assistant in the Firm assigned to that particular case. Upon review of the file related to the above-captioned application, we did not find a copy of the Office Action dated March 18, 2008 or any reporting letter to the client of that Office Action.

11. While I am not in a position to address the PTO's records, I can state that a search of our records, including any file jacket or the equivalent, and the application contents, fails to reveal the presence of the Office Action of March 18, 2008. Thus, on or about October 8,

2008 was the first time that I saw the Office Action dated March 18, 2008.

12. I am aware of Ms. Rios' review of the Firm's electronic records and paper file. Additionally, I did not see the presence of the Office Action of March 18, 2008, or any PTO post card reminder that the Private PAIR records were not reviewed for that Office Action. Furthermore, my review with Ms. Rios of the Firm's docket system showed no entries for responding to the Office Action of March 18, 2008, or for reporting that Action to the client.

13. I have reviewed the copies of the records used by my Firm, where the Office Action of March 18, 2008, would have been entered had it been received, labeled as Exhibits A-F in the Renewed Petition and hereby state that to the best of my knowledge, they are accurate.

14. Exhibit A is a print-out of the records that I reviewed that Ms. Rios printed out, which is a PROLAW system docket specifically for the application at issue (attorney's docket number P13205). If the Office Action at issue had been received, it would have been pointed out to me by Ms. Zhang and she would have made entries in Exhibit A to show that for attorney's docket number P13205, an Office Action dated March 18, 2008 was received. Additionally, she would have entered the date of the Office Action in PROLAW, which would have automatically generated entries for the due dates, with or without extensions of time. As can be seen from Exhibit A, no such entries are present and I do not recall ever discussing such entries with Ms. Zhang or Ms. Rios.

15. Exhibit B is a print-out of the records that I reviewed that Ms. Rios printed out,

which is a PROLAW docket calendar for the months of March (starting on March 17, 2008), April, May, June, July, August and September (up to September 28, 2008). If the Office Action at issue had been received, it would have been pointed out to me by Ms. Rios or Ms. Zhang and one or the other would have made entries to show in Exhibit B that for attorney's docket number P13205, certain due dates for entries such as "Detailed Analysis of the Office Action," "Response to Office Action due," "Reminder sent to Client regarding Office Action," "Instructions received from Client?," "Detailed Analysis sent to client?," etc: would have to be met. As can be seen from Exhibit B, no such indications or entries appear for P13205.

16. In addition to the above, I reviewed Ms. Zhang's and Ms. Rios' work with the Yahoo calendar for the Yahoo docketing system at HersHKovitz & Associates, LLC. When an Office Action is received, the docketing manager would make entries in this calendar with Mr. Nguyen or my approval, the due date for reporting the Office Action to the client (within three days of receipt), the due date for receiving instructions from the client (two weeks before the due date for replying to the Office Action), and reminder dates to send to the client if instructions have not been received (on each due date including extended periods for response and two weeks before the date of abandonment). On the Yahoo calendar system, once something is completed, Ms. Zhang or Ms. Rios would have deleted it from this calendar upon Mr. Nguyen's or my approval. If not completed, the entry for the particular case would be moved to a later date, again with the approval of Mr. Nguyen and me. Thus,

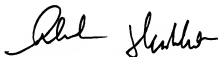
this calendar changes daily based on the changes made in the calendar. As can be seen from Exhibits C and D, no entries remain for P13205.

17. While I am not in a position to address the PTO's records regarding review of the e-mail notification, I can state that I have not seen a copy of the Office Action dated March 18, 2008 for the patent application at issue, any related mail from the USPTO regarding this, nor have discussed any entries to be made by Ms. Rios or Ms. Zhang in the Yahoo docket or the PROLAW docket for the Firm that would indicate that the Office Action was received on or about March 18, 2008.

18. Additionally, the Firm has a Legal Assistant who has as one of her responsibilities checking cases on the "awaiting client instructions" shelf. This is a designated shelf in our Firm for applications where an Office Action has been received and the Firm is awaiting the client's instructions. Applications that are on this shelf would be checked every month by this Legal Assistant for due dates and reminders. From the months of March 2008 to September 2008, had she found the file for the instant application (i.e., Petitioner's file having attorney's docket number P13205), on this shelf with respect to the Office Action dated March 18, 2008, she would have brought it to Mr. Nguyen's attention. In fact, based on

information and belief, at the time of receiving the Notice of Abandonment on or about October 8, 2008, the file was found on a regular filing shelf, rather than the “awaiting client instructions” shelf.

January 2, 2009

A handwritten signature in black ink, appearing to read 'Abraham HersHKovitz', written over a horizontal line.

Abraham HersHKovitz

Reg. No.: 45,294